

## **REMARKS**

Claims 1-3, 9, 14 and 16-31 are currently pending in the application. Claims 1, 2, 3, 9, 20-22, 25, 28 and 32 are in independent form.

Claims 1, 9, 16, 17, 18, 19, 20, 21, 28, 29, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being anticipated by the Immel patent. Reconsideration of the rejection under 35 U.S.C. § 103(a), as anticipated by the Immel patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103."

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281,297, 227 U.S.P.Q. 657,667. As stated, the District Court concluded:

"Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art which would have made such a combination appropriate."

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

The Office Action holds that the Immel patent discloses an assembly having all of Applicant's claimed structure including a resilient pin retainer and a pin for operatively locking a wear member to a support structure. However, when read more specifically, the Immel patent teaches a lock block 41, which is a rigid lock block. Since it is rigid, it cannot be resilient. The rigid lock block acts to prevent unintentional rotation of the pin 39. The Immel patent discloses use of a lock ring 55 and groove 57 to prevent unintentional axial movement of the pin 39. In addition to the rigid lock block 41, the Immel patent also discloses use of a resilient member 43. The resilient member is a component distinct from the rigid block 41. The resilient member, when compressed, urges the tooth tip into maintaining a nose-contacting position whereby the tooth tip will be more firmly retained on the nose of the support against the action of tooth-removal forces during use of the tooth. (See claim 1, column 8, lines 7 to 8.) This is an entirely different function than that of a pin retainer. Further, the resilient member 43 taught by the Immel patent is compressed between the pin and the tooth tip. It is therefore evident to a skilled person that the resilient member must bear at least half of the wear member-removal forces between the pin and the tooth. The other portion of the wear member-removal forces must be borne by the pin foot.

In contrast, the presently pending independent claims recite that the pin retainer be a resilient pin retainer. The resilient pin retainer allows rotation of the pin, but prevents unintentional axial movement of the pin. The prevention of rotational

movement is a different and separate function from prevention of axial movement. The Immel patent teaches additional components, i.e. the lock ring 55 and groove 57, to prevent unintentional axial movement of the pin. Thus, the resilient pin retainer of the presently pending independent claims has a different function from the rigid lock block disclosed in the Immel patent. Further, if the rigid lock block taught by the Immel patent was in fact resilient, it could not serve its function. It is required to be rigid in order to lock the pin and maintain contact between the ridges on the pin and the ridges on the block. Without such contact, locking engagement is not achieved. The presently pending independent claims recite that the resilient pin retainer is substantially non-load bearing with respect to the wear member-removal forces during use of the wear member. This is an important feature of the claimed resilient pin retainer. Resilience of the pin retainer is necessary so the pin can tilt into metal to metal contact with the wear member and support structure (tooth and adapter) when the assembly is in use. The Immel patent does not teach a resilient member for the purpose of allowing metal to metal contact between the pin, the tooth, and the adapter. In fact, the resilient member taught by the Immel patent bears tooth-removal forces and prevents such contact. Accordingly, the presently pending independent claims are patentable over the prior art and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above. The prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

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Connie Herty